

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Ralf Peter Mueller Group Art Unit: 3724
Serial No.: 10/565,871 Examiner: Alie, Ghassem
Filed: 07/27/2006 Conf. No. 7341
For: AXIALLY-DISPLACEABLE CUTTER AND CUTTING GAP ADJUSTMENT
Attorney Docket No.: 1401D-003

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PRE-APPEAL BRIEF REQUEST FOR REVIEW (WITH EXTENSION OF TIME)

Following a Final Office Action dated January 6, 2009, Applicants submit the present Request for Formal Review, by a panel of Examiners, of the legal and factual basis of the rejections pending in the present case, in accordance with the Pre-Appeal Brief Conference Pilot Program¹. Applicants believe that the issues presented are well posed for appeal, and request formal review prior to appeal on the grounds that the publications upon which the Office relies do not satisfy 35 U.S.C. §102(b), because they published less than one year prior to the present priority date. Even if the publications are prior art, by reliance upon un-translated foreign language documents, conclusory statements, and unsubstantiated determinations of inherency, the Office has not met its burden to prove anticipation and obviousness.

BACKGROUND SYNOPSIS OF SUBJECT MATTER

The present application relates to a slicing device for slicing food products having a rotating cutting blade mounted so as to be displaceable parallel to its axis of rotation. The use of one or more counterweights displaced in the opposite direction from the cutting blade stabilizes running of a cutting blade of the device. This has an advantage in that the acceleration forces and moments are suppressed during axial displacement of the rotating blade, such that the slicing machine is prevented to the greatest possible extent from vibrating. Acceleration forces or moments arising are compensated. Torque may be measured, and the measurement used for adjusting the machine. Through separate adjustment of the counterweight independently of the axial displacement of the blade, forces and/or moments which arise for example as a result of blade imbalances caused by wear or sharpening may be

¹ Official Gazette of the United States Patent and Trademark Office (herein "**Office**"), vol. 1296, No. 2 (7.12.05).

eliminated. Further, the position of the cutting blade relative to its zero point may be known and controlled at all times.

CLAIM OBJECTIONS

The Office objects to claims 41, 50 and 53 because of certain alleged informalities. Applicants believe that the objection is unwarranted, and that the claims are readily understood. No amendment is believed necessary. However, in the interest of advancing prosecution, Applicants are agreeable to make the suggested amendment in its Appeal, or in the course of further prosecution should the Appeal prove unnecessary in view of the present submission.

CLAIM REJECTIONS UNDER 35 U.S.C. §§ 102(b) AND 103

The publications upon which the Office relies to support the rejections under 35 U.S.C. §102(b) are not prior art, because they published less than one year prior to the priority date to which the present claims are entitled. Weber (WO 03/028963 A1) published April 10, 2003 (DE 10147348 A1) published April 17, 2003. Schmidt (DE 10155408 A1) published May 22, 2003. The priority applications to which the present application claims the benefit were filed, respectively, July 23, 2003 and December 16, 2003². For an item to be statutory prior art, 35 U.S.C. §102(b) requires that it be published "more than one year prior to the date of application for patent in the United States." Because Weber and Schmidt published less than one year before the priority date for the present application, they are not prior art under 35 U.S.C. §102(b). The rejections of claims 41, 43-44, 53-54 and 68-69 should be withdrawn on this basis.

Even if Weber and Schmidt could be relied upon under Section 102, the Office has not met its burden to show correspondence in the publications for each and every element claimed. See, ***Net Money!N Inc. v. VeriSign Inc.***, 88 USPQ2d 1751 (Fed. Cir. 2008). As to Weber, the Office does not show plausible correspondence for the requirement of a counterweight that "is axially displaced in the opposite direction from the cutting blade" (claims 41, 43, 44 and 68-69),

² This flaw was pointed out to the Examiner in the interview of February 4, 2008. It was again emphasized on page 6 in the Response and Amendment dated February 25, 2008. In support of that filing, Applicants filed a copy of the July 23, 2003 priority document (DE 10333661) accompanied by an automated translation, along with a copy of the December 16, 2003 priority document (DE 10359149), also with an automated translation. Even a cursory review of the priority documents, without any translation, illustrates that the drawings are substantively the same as those used in the PCT application. Figs. 1-3 of DE 10333661 compare with Figs. 1-3 of PCT/EP2004/008265. Figs. 1-6 of DE 10359149 compare with Figs. 4-9 of PCT/EP2004/008265. The Declaration and Power of Attorney for Patent Application makes claim of priority to these applications. No defects in the Declaration have been raised by the Office, and the Application was accepted on July 27, 2006, upon filing of the Declaration.

or a step of “axially displacing a counterweight on a drive shaft of the cutting blade in an opposite direction” from the cutting blade (claims 50-56). Rather, the Office has made factual findings that are unsupported by the evidence. For example, the Office identifies as the purported “counterweight” what the Office refers to as “the flange or end portion of the first part 5”. The Office does not specify upon which end it relies. The confusion is compounded when the Office then refers to part 5 as “drive shaft 5”. In finding that “part 5” is a drive shaft, the Office ignores that the German specification calls out “part 5” as a “stationärer erster teil”. A simple translation of this German phrase (using Google Translate) shows that it means “**stationary** first part” (emphasis added). When this clause is inserted into the rejection, the rejection becomes even more nonsensical, as the Office’s rejection calls for a part that is explicitly characterized as **stationary** to be **axially displaced**. In short, the Office has not shown how any alleged counterweight in Weber displaces axially from the blade. All of the Office’s reasons for rejection are premised upon this improper finding. The Office has not met its burden to show that Weber anticipates the claims 41, 43-44, 50-54 and 68-69.

As to Schmidt, in conclusory manner³, the Office asserts as findings that the claimed features exist, but does not point out with particularity the location in Schmidt where such feature is taught. By way of example, the Office supplies no location where Schmidt teaches:

- 1) that a counterweight is axially displaced during operation of the machine, specifically in the opposite direction from a rotating cutting blade;
- 2) that displacement of the cutting blade, the counterweight, or both takes place independently of a rotational speed of the cutting blade;
- 3) adjustment of a cutting gap; or
- 4) any effect on axial position of the cutting blade after it has come into contact with an adjusting limit stop; or
- 5) any step of axially displacing a counterweight to compensate for forces, moments, or both arising during displacement of the blade.

The Office also has engaged in improper inherency fact finding as to Weber and Schmidt. See MPEP 2112 (Quoting "To establish inherency, the extrinsic evidence 'must make

³ The Office purports to rely upon an abstract translation of Schmidt. However, the reliance upon Schmidt appears to be based upon the alleged abstract and Figs. 1-5. To the extent the Office relies upon passages elsewhere in Schmidt, the Office is required to supply a complete translation. MPEP 706.02 states, in pertinent part:

To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection.

clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

As to Weber, the Office asserts "inherency" in the statement on Page 4 (first full paragraph), without more: "In addition, Weber teaches that the forces and/or movements arising during displacement of the blade are inherently compensated." The Office has failed to properly satisfy its burden under MPEP 2112 to show compensation for forces and/or movements arising during displacement of the blade. There has been no showing by the Office that compensation by the counterweight for forces and movements by the blade is necessarily a result of the operation of the Weber machine.

As to Schmidt, the Office asserts, at page 4 (¶6) of the January 6, 2009 Office Action that the Schmidt "displacement mechanism 15 **could** displace the blade independently in opposite direction than the counterweight." (emphasis added) There is no finding that it ***necessarily*** does so while the blade is rotating. Similarly, at Page 5 (first full paragraph), the Office uses the uncertain **could** to characterize the teachings of Schmidt. Again, the requirement for inherency is that it necessarily must meet the claim requirement, not that it "might" or "could".

Likewise, as to claims 43-44 and 68-69, there has been no showing by the Office that the so-called "adjustment mechanism 15"⁴ inherently "includes a limit that limits the adjustment of the blade". First, the Office has found element 15 to be an "adjustment mechanism". The iGoogle German to English translation of "radialstiftes" shows that word to mean "radial pin". Accordingly, to the extent that the rejection relies upon the assumption that element 15 is an adjustment mechanism, it is without support. Additionally, there has been no showing by the Office that element 15, as employed specifically in the combination shown in Schmidt necessarily functions as a limiting stop.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

The Office additionally relies upon Weber and Schmidt as alleged prior art under 35 U.S.C. §103. For the reasons set forth above, Weber and Schmidt are not statutory prior art

under §102(b) and, therefore, cannot be relied upon to support a rejection under §103. As set forth above, Applicants believe the rejections are based upon insufficient fact finding. The Office has identified a number of facts that are unsupported by evidence. Applicants also believe that the Office Action did not set forth an appropriate reasoning and analysis to satisfy the Supreme Court's requirements from *KSR International co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385, 1396 (2007). The Office has the burden to explicitly analyze:

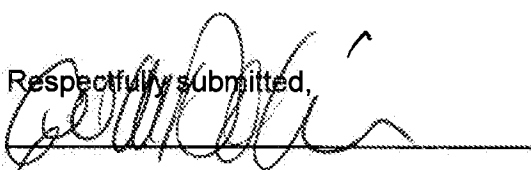
. . . interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")....

CONCLUSIONS

For the above reasons, withdrawal of the rejections and allowance of the pending claims is respectfully requested. If the rejection is to be upheld on the basis of Weber and/or Schmidt, then Applicants submit that the burden is upon the Office to provide a complete translation of Weber and Schmidt and to point out with particularity where correspondence is found in these documents. Applicants respectfully request and petition an appropriate extension of time to respond to the outstanding Office Action, of at least one (1) month. Please charge Deposit Account 50-1097 in the amount of \$130.00. For any deficiencies, please charge Deposit Account No. 50-1097 for any fee which may be due is hereby given.

Dated: April 30 2009

Respectfully submitted,


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⁴ Relying solely upon the Abstract and drawings, the Office has found element 15 to be an "adjustment mechanism". However, in paragraphs 24, 25, 26 and 27, Schmidt uses reference numeral 15 to denote a "radialstift" or "radialstiftes". The iGoogle German to English translation of "radialstiftes" shows that word to mean "radial pin".